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REMARKS

Claims 1-8, 10, 32-41, and 52-58 are currently pending in the application. By this amendment, claims 1, 32, and 52 are amended and claims 57 and 58 are added for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for the amendments is provided at pages 8, 9, and 15 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. §103 Rejection

Claims 1-8, 10, 32-41, and 52-56 were rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent Publication No. 2002/0198727 issued to Ann, et al. ("Ann") in view of U.S. Patent Publication No. 2003/0158800 issued to Pisello, et al. ("Pisello"). This rejection is respectfully traversed.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

¹ While the KSR court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, --- U.S. ----, 127 S.Ct. 1727, 1731 (2007)).

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combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2142. Applicants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

Claims 1, 32, and 52

Claim 1 recites, in pertinent part:

... partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and automating the management of the categories of the information by an automation system, the information being defined by at least one of the value, the at least one capability, and operational resources; and

using one or more external process modeling tools to determine a performance associated with the enterprise architecture, wherein the one or more external process modeling tools are configured to capture one or more process measurements and link the one or more process measurements to a database.

Claim 32 recites, in pertinent part:

... a means for partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and automating the management of the categories of the information by an automation system, the information being defined by at least one of the value, the at least one capability, and operational resources; and

a means for using one or more external process modeling tools to determine a performance associated with the enterprise architecture, wherein the one or more external process modeling tools are configured to capture one or more process measurements and link the one or more process measurements to a database.

Claim 52 recites, in pertinent part:

... a fifth computer code to partition information relevant to enterprise decision making for evolutionary change by creating categories

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of the information and relating these categories to one another and automating the management of the categories of the information by an automation system, the information being defined by at least one of the value, the at least one capability, and operational resources; and
a sixth computer code to use one or more external process modeling tools to determine a performance associated with the enterprise architecture, wherein the one or more external process modeling tools are configured to capture one or more process measurements and link the one or more process measurements to a database.

- I. Neither Ann nor Pisello partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and automating the management of the categories of the information by an automation system, the information being defined by at least one of the value, the at least one capability, and operational resources.

The Examiner asserts that Ann partitions information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another. However, Applicants submit this is not the case. Instead, Ann includes an enterprise architecture with business and information technology components and defined linkages between them, which allow for the impact of changes in one component to drive the other component. (Paragraph [0006].) Figure 5, which the Examiner relies upon on page 3 of the Office Action, describes this enterprise architecture and shows the relationship between various drivers of a business. (Paragraph [0023].) For example, the business defines strategic directions, which deliver strategies to capabilities. The capabilities drive the principles, which in turn control the capabilities. The enterprise technology framework and application software, which are part of the IT framework, are used to provide a framework based on the principals. This is done in part by using processes from the business architecture, which enable the capabilities. (See paragraphs [0041] – [0046] for a further explanation of the relationships in FIG. 5.)

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As is apparent from FIG. 5, and the description thereof, Ann includes a number of components and describes how the components are linked together. However, there is no indication anywhere in Ann that information is partitioned and the Examiner has not identified any specific disclosure in Ann to support this assertion. Moreover, even if information is partitioned, which Applicants do not concede, Ann provides no disclosure on partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another. As such, Applicants submit claims 1, 32, and 52 are not obvious for at least this reason.

The Examiner further asserts that Ann automates the management of the categories of the information by an automation system. To support this assertion, the Examiner relies on paragraph 0029 in Ann, which discloses storing an enterprise architecture in any convenient tool, repository, or in data processing system in the form of a Lotus Notes database. However, Applicants submit that there is no disclosure in Ann that the mere storage of an enterprise architecture requires an automation system. Furthermore, there is certainly no disclosure in Ann that the storage of an enterprise architecture involves automating the management of categories. As such, Applicants submit that Ann does not automate the management of the categories of the information by an automation system. For at least this reason, Applicants submit that claims 1, 32, and 52 are not obvious.

Applicants further submit that Pisello does not make up for the deficiencies of Ann. In particular, the Examiner relied on Pisello to set forth rejections of claims 1, 32, and 52 in the last Office Action, which was dated March 11, 2008. In response to that Office Action, Applicants amended claims 1, 32, and 52 to advance prosecution. That amendment added the feature of partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another and automating the management of the categories of the information by an automation system, the information being defined by at least one

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of the value, the at least one capability, and operational resources. The Examiner recognized on page 3 of the present Office Action that this amendment overcomes the Examiner's previous rejections in view of Pisello. Applicants agree and submit that claims 1, 32, and 52, as currently amended, are not obvious over Ann in view of Pisello. As such, Applicants respectfully request that the rejection of claims 1, 32, and 52 be withdrawn.

II. Neither Ann nor Pisello use one or more external process modeling tools to determine a performance associated with the enterprise architecture, wherein the one or more external process modeling tools are configured to capture one or more process measurements and link the one or more process measurements to a database

In addition to the foregoing distinguishing features of Applicants claims 1, 32, and 52, Applicants submit that Ann fails to disclose one or more external process modeling tools to determine a performance associated with the enterprise architecture, wherein the one or more external process modeling tools are configured to capture one or more process measurements and link the one or more process measurements to a database. In contrast to the above-noted feature, Ann coordinates an organization's business objectives with its overall information technology environment by linking together components within a single framework. The way in which the links are formed between the business objectives and the information technology environment is discussed in detail in paragraphs [0027] – [0047] and are illustrated in figure 4. By linking together components in the fashion described in paragraphs [0027]-[0047], Ann can understand, assess, and manage the impact of a change to any one or more of the components prior to implementation.

Accordingly, while Ann teaches how to link components together in a single framework, there is no evidence that Ann discloses one or more external process modeling tools to determine a performance associated with the enterprise architecture. Moreover, even assuming *arguendo* that Ann does use one or more external process

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modeling tools, which Applicants do not concede, there is no indication that any such structures deemed to be external modeling tools in Ann are configured to capture one or more process measurements and link the one or more process measurements to a database. As such, Applicants submit that Ann does not include at least this feature of claims 1, 32, and 52.

Applicants further submit that Pisello fails to disclose one or more external process modeling tools to determine a performance associated with the enterprise architecture, wherein the one or more external process modeling tools are configured to capture one or more process measurements and link the one or more process measurements to a database. Instead, Pisello is directed to financially evaluating information technology projects. (Paragraph [0002].) Pisello does this via a software module that accepts input about an organization from users. (Paragraph [0024].) This input may include information about a project such as the project name, a short description of the project, a project start date, etc. (Paragraph [0030].) The software module uses the collected input to calculate indices such as net present value, return on investment, internal rate of return, payback period, etc. (Paragraph [0056].)

Therefore, Pisello is directed to financially evaluating information technology projects based on data collected from users about the project. However, Pisello fails to disclose one or more external process modeling tools to determine a performance associated with the enterprise architecture. Additionally, even assuming *arguendo* that Pisello were to show this feature, which Applicants submit Pisello does not, there is no indication that any such structures deemed to be external process modeling tools in Pisello are configured to capture one or more process measurements and link the one or more process measurements to a database. Accordingly, Applicants submit that Pisello does not include at least this feature of claims 1, 32, and 52. As neither Ann nor Pisello show this feature, Applicants respectfully request the rejection of claims 1, 32, and 52 be withdrawn.

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Dependent Claims

Claims 2-8, 10, 33-41, and 53-56 are dependent claims, depending from distinguishable independent claims 1, 32, and 52, respectively. For these reasons, Applicants submit that these claims are allowable for at least the reasons discussed above with respect to independent claims 1, 32, and 52. Accordingly, Applicants respectfully request the rejection of claims 2-8, 10, 33-41, and 53-56 be withdrawn.

Other Matters

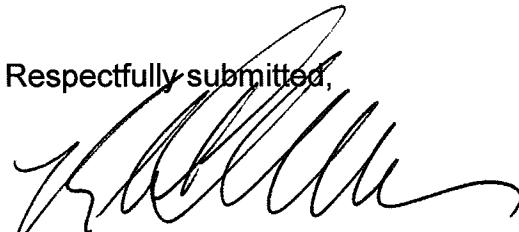
Claims 57 and 58 are added for the Examiner's consideration. Applicants submit that claims 57 and 58 contain allowable subject matter. Moreover, no combination of the applied references teach or suggest the features of claims 57 and 58.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,


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